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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,863	01/31/2001	Karl R. Olsen	9218/	2599
22922	7590	02/01/2006	EXAMINER	
REINHART BOERNER VAN DEUREN S.C. ATTN: LINDA KASULKE, DOCKET COORDINATOR 1000 NORTH WATER STREET SUITE 2100 MILWAUKEE, WI 53202			NGUYEN, NGA B	
			ART UNIT	PAPER NUMBER
			3628	
DATE MAILED: 02/01/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/774,863

Applicant(s)

OLSEN, KARL R.

Examiner

Nga B. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 3-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/31/05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the communication filed on September 26, 2005, which paper has been placed of record in the file.
2. Claim 2 has been canceled. Claims 1 and 3-19 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1 and 3-19 have been considered but are not persuasive.

In response to applicant's arguments regarding to Chang reference (US. 5,848,400) that Chang does not disclose "any single word" teaching "obtaining information on customers through the processing of payment from them to enable the presentment of bills to such customers", examiner submits that Chang **does** teach "obtaining information on customers through the processing of payment from them to enable the presentment of bills to such customers", see column 4, lines 52-57, the bill processor 222 receives an electronic bill from a bill issuer, the bill processor 222 then posts it to the appropriate client bill mailbox 226, also see column 5, lines 43-50, after one or more electronic bills be been posted to the bill mailbox 226 for a given client, the client may review and pay for the bills. Thus, the Chang's system obtains the customer bills from the bill issuer and transmits and presents the bills to the customer, allows the customer review and pay for the bills.

In response to applicant's arguments regarding to claims 2, 18, and 19, examiner submits that applicant has not submitted any rebuttal of the well known

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statements, but has merely requested references disclosing the well known limitations. Furthermore, the applicant must be given the opportunity to challenge the correctness of such assertions and allegations. Again, the applicant has not challenged the correctness of the assertions, only the use of Official Notice. Bald statements such as "the examiner has not provided proof that this element is well known" or "applicant disagrees with the examiner's taking of Official Notice and hereby requests evident in support hereof", are not adequate and do not shift the burden to the examiner to provide evidence in support of the Official Notice. Allowing such statements to challenge Official Notice would effectively destroy any incentive on the part of the examiner to use it in the process of establishing a rejection of notoriously well known faces (*In re* Boon, 169 USPQ 231 (CCPA 1971)). Therefore, the examiner decides to maintain the Official Notice taken in the previous office action.

4. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 4, 7-11, 13, and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al (hereinafter Kolling), U.S. Patent No. 5,963,925.

Regarding to claim 1, Kolling discloses a method for electronic bill presentation and payment, comprising the entity steps of:

obtaining a plurality of bill files, each bill file associated with a particular billing and a particular billing account maintained at a biller's financial institution, each bill file including a plurality of records, each record identifying a particular invoice account and a corresponding balance representing a financial obligation owed by a corresponding customer to the billing entity (column 11, lines 29-42 and column 28, lines 1-16, 27-63; a statement origination workstation (SORG) 208 is operated by coordinating entity 120, biller 102, a Biller Financial Institution (BFI) or a Biller Service Provider (BSP) receives a plurality of batches (equivalent to bill files), each batch including a plurality of statement content records (SCR), each SCR including customer name, customer address,

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statement data (column 16, lines 45-65; statement data includes customer name, address, account number, type of service, units used, total cost, etc...), consumer's biller account number, etc.);

obtaining a payment made by the customer remunerated to the billing entity (column 30, lines 5-18, customer makes payment by check or by electronic bill payment);

associating a customer's financial institution data with a routing address (column 28, line 53-column 29, line 33; sorting all of the statement content records by SGEN identifier, batches of records sorted by SGEN identifier are routed to the appropriate physical SGEN; column 13, lines 1-13; SGEN is located at the Customer Financial Institution (CFI));

obtaining customer account identification information identifying the corresponding customer's account at the customer's financial institution (column 27, lines 4-6; SORG retains the CSP identifier, the DSP account number, biller identifier, etc.);

processing records in each bill file by:

assembling a bill packet corresponding to the bill record, the bill packet including information from the corresponding bill record and the customer's account identification information (column 13, lines 13-32; SGEN assembles each electronic statement by merging the appropriate template from a particular biller with standard statement data representing a customer of that biller); and

transmitting the bill packet to an electronic repository corresponding to the customer's financial institution using the associate routing address (column 13, lines 15-17; transmitting the electronic statement to CFI); and

processing the bill packets received by each electronic repository by:

sorting the received bill packets by customer's account information (figure 12 and column 31, lines 35-55; consumer login to the bank account maintained at the Midwest Federal Bank, a list of subscriptions displayed, including Cyber Bell, Great Northern bank, Network Gas & Electric, and ABC Cable);

assembling a bill presentation file containing information from the received bill packets for each customer account (column 29, lines 45-60; SGEN executes statement generation program, the electronic statement is represented in PDF file); and

electronically presenting each bill presentation file for viewing and electronic bill payment (figure 16 and column 32, lines 25-45; a sample make payment screen is displayed, make payment screen includes button for viewing accounts, payments, payee, etc.).

Kolling does not disclose data mining the payment to obtain data that distinctly identifies the financial institution where the customer maintains the account upon which the payment is drawn. However, data mining the payment to obtain data that distinctly identifies the financial institution where the customer maintains the account upon which the payment is drawn is well known in the art. For example, Kolling does disclose customer can makes payment by check directly to the biller or by submitting electronic payment to CFI so that payment information is transmitted back to biller (column 30,

lines 5-18). Thus, it is obvious that biller can easily to obtain customer's financial institution data such as CFI identifier, CFI routing and transit number, etc...because such data included in the check. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Kolling's for the purpose of providing more convenient to the biller to obtain customer's financial institution data from the payments made by customers in order to encourage customers participating in electronic bill payment.

Regarding to claims 3-4, Kolling does not teach the customer's financial institution data include an American Bankers Association routing and transit number or an International Organization for Standardization issuer identification number. However, Kolling does teach customer can makes payment by check directly to the biller or by submitting electronic payment to CFI so that payment information is transmitted back to biller (column 30, lines 5-18). Moreover, American a Bankers Association routing and transit number is well known authentication data contained in a check, an International Organization for Standardization issuer identification number is well known authentication data contained in credit transaction. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Kolling's to include the feature above for the purpose of providing more easily and convenient for the biller to transmit electronic bill to the appropriate customer's financial institution.

Regarding to claim 7, Kolling discloses the step of assembling a bill packet further comprises the step of encrypting the bill packet (column 33, lines 30-40).

Regarding to claim 8, Kolling does not disclose the step of processing the bill packets received by each electronic repository further comprises the step of decrypting the bill packet. However, Kolling does teach all financial transaction messages are transmitted in encrypted form, thus the messages must be decrypted in order to be viewed by any entity such as the financial institution or the customer, moreover, decrypting messages using a proprietary decryption technique is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Kolling's for the purpose of providing the security to prevent the unauthorized user to gain access to the security information.

Regarding to claim 9, Kolling discloses the step of assembling a bill packet further comprises the step of attaching to the bill record a Universal Resource Locator of a server operated by the billing entity to enable the customer to find detailed billing information (column 19, lines 20-30; the summary section could include a URL for customer access to detailed transaction records).

Regarding to claim 10, Kolling discloses the step of electronically presenting each bill presentation file for viewing and electronic bill payment further comprises the steps of: providing securing for accessing the bill presentation file to ensure the privacy of any information displayed; providing security to ensure the confidentiality of any payment information received (figure 11 and column 31, lines 19-35; after clicking the login hot spot 866, the customer would be challenged for identification, in a login screen the

customer might be asked to supply a user name, a code number or other authentication).

Regarding to claims 11 and 13, Kolling discloses the steps of electronically presenting each bill presentation file for viewing and electronic bill payment includes receiving authorization to debit a direct deposit account at the customer's financial institution and debiting the customer's direct deposit account (figure 16, "Method of Payment" 946).

Regarding to claims 15 and 17, Kolling discloses recording the payment by the customer in a customer payment warehouse database (figure 12 and column 31, lines 45-45, history button 879 allowing customer to view history invoices or payments) and recording the payment to billing entity in a bill payment warehouse database (column 9, lines 23-25, biller's account receivable database).

Regarding to claim 16, Kolling discloses sending an automated payment to the biller's financial institution that originated the bill; crediting the billing account owned by the biller at the biller's financial institution; and notifying the billing entity that the bill has been paid (column 9, lines 14-25).

Claim 18 contains similar limitation found in claim 1 above, therefore, is rejected by the same rationale.

Regarding to claim 19, Kolling discloses a system for electronic bill present and payment, comprises the steps of:

obtaining a payment made by a customer remunerated to a billing entity (column 30, lines 5-18, customer makes payment by check or by electronic bill payment);

associating the customer's financial institution data with a routing address (column 29, lines 1-10, CSP has a remote mail station identifier to enable the data to be sent to the correct CSP);

transmitting a bill packet to an electronic repository corresponding to the customer's financial institution using the associated routing address (column 29, lines 1-10, the batches of records sorted by SGEN identifier are routed to the appropriate physical SGEN and then on the appropriate DSP, the SGEN identifier is mapped to a remote mail station identifier to enable the data to be sent to the correct CSP).

Kolling does not disclose data mining the payment to obtain customer's financial institution data that distinctly identifies a customer's financial institution. However, data mining the payment to obtain customer's financial institution data that distinctly identifies a customer's financial institution is well known in the art. For example, Kolling does disclose customer can make payment by check directly to the biller or by submitting electronic payment to CFI so that payment information is transmitted back to biller (column 30, lines 5-18). Thus, it is obvious that biller can easily obtain customer's financial institution data such as CFI identifier, CFI routing and transit number, etc...because such data included in the check. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Kolling's for the purpose of providing more convenient to the biller to obtain customer's financial institution data from the payments made by customers in order to encourage customers participating in electronic bill payment.

7. Claims 5, 6, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al (hereinafter Kolling), U.S. Patent No. 5,963,925, in view of Chang, U.S. Patent No. 5,848,400.

Regarding to claims 5-6, Chang discloses obtaining a routing address comprises the steps of: associating the customer's financial institution with a globally unique identifier; receiving an Internet Protocol address corresponding to the globally unique identifier; loading information into a look-up table database that correlates the customer's financial institution with the Internet Protocol address (column 5, lines 13-22; mapping financial institution identifications into financial transaction server network identifiers, loading network identifiers into a routing able 231). Chang does not teach registering the globally unique identifier with an Internet Domain Name Service. However, Chang teaches each customer's financial institution has an network identifier, moreover, in order to have an network identifier, it is well known in the art that each customer's financial institution must registers with an Internet Domain Name Service. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Kolling's to adopt the teaching of Chang above for the purpose of obtaining an network identifier for each customer's financial institution in order to route the electronic bills to the customer's financial institution.

Regarding to claims 12 and 14, Kolling does not disclose the step of electronically presenting each bill presentation file for viewing and electronic bill payment includes authorization to charge a credit card of the customer and charging the customer's credit card. However, Chang discloses the step of electronically presenting

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each bill presentation file for viewing and electronic bill payment includes authorization to charge a credit card of the customer and charging the customer's credit card (column 5, lines 43-60 and column 7, lines 50-67). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Kolling's for the purpose of providing more convenient to the customer to submit payment using credit card.

Conclusion

8. Claims 1-19 are rejected.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (571) 272-6799.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

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Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

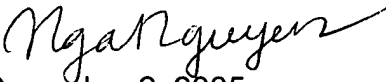
or

(571) 273-0325 (for informal or draft communication, please label

"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany
Street, Alexandria, VA, First Floor (Receptionist).

Nga B. Nguyen

A handwritten signature in black ink, appearing to read 'Nga B. Nguyen', written in a cursive style.

December 2, 2005